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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JURGEN SCHMIDT-THUMMES, JURGEN HARTMANN and
CHUNG-JI TSCHANG

Appeal 2010-003287
Application 10/541,206
Technology Center 1700

Oral Hearing Held: Tuesday, January 11, 2011

20 Before ADRIENE L. HANLON, PETER KRATZ and
21 LINDA M. GAUDETTE, *Administrative Patent Judges.*

2.3 APPEARANCES:

25 ON BEHALF OF THE APPELLANT:

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35 The above-entitled matter came on for hearing on Tuesday,
36 January 11, 2011, commencing at 12:59 p.m., at the U.S. Patent and
37 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
38 Alexandria, Virginia, before Lori B. Allen, notary public.

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PROCEEDINGS

3 THE CLERK

4 : Appeal Number 003287, Mr. Koschmieder.

5 JUDGE HANLON: Before we start, I'd just like to ask who is
6 attending in the back. I see you're from the outside?

7 OBSERVER 1: Yes, I'm just observing.

8 JUDGE HANLON: Okay. And you are as well?

9 OBSERVER 2: I'm observing as well. I'm with an attorney on
10 later.

11 JUDGE HANLON: Okay. So, Mr. Koschmieder, you have 20
12 minutes. Whenever you're ready, you can begin.

13 DR. KOSCHMIEDER: Okay. Just to be sure that this is correct
14 on the record, today we're in an oral hearing for Application Number
15 10/541206. Should I spell my name for the record also?

16 JUDGE HANLON: If you have a card, she could take that either
17 now or after the --

18 DR. KOSCHMIEDER: Okay. In any case, let me spell it for
19 you, because it's not an easy name. First name, Stefan, S-t-e-f-a-n; last name,
20 Koschmieder, K-o-s-c-h-m-i-e-d-e-r. And, if it pleases the board, I'll just start
21 with some comments unless you have some questions you'd like to start with.

22 JUDGE HANLON: No. You may begin.

23 DR. KOSCHMIEDER: Thank you.

24 We have a rejection that starts with what I'm going to call the

²⁵ Orsowicki reference or Ostrowicki reference. Spelling is O-s-t-r-o-w-i-c-k-i,

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1 U.S. Patent 591,534, an obviousness rejection. The examiner has taken the
2 position that the claimed invention is very similar to what is described in
3 Ostrowicki, except for the particular feature of the order of addition or the
4 order of a neutralization of a monomer. And the examiner has taken the
5 position that that order or addition would be rendered obvious by
6 modification of Ostrowicki in view of some other prior art. But, first of all,
7 what I'd like to do is take a minute to talk about Ostrowicki and explain how
8 Ostrowicki is already distinguished in the specification.

9 So in the original specification -- I believe it's on page 1 or page
10 2 -- there are some references given to other applications; in particular,
11 European Application identified as EPB 819708; and, just for the record, that
12 represents the European equivalent that corresponds with Ostrowicki, which
13 is a side of this prior art in this case. The point or the reason I bring that up is
14 to make it clear that applicants are aware of the Ostrowicki reference and the
15 application was drafted with that in mind.

16 Now, of course, as the Examiner has conceded, Ostrowicki does
17 not in fact describe the feature of our invention with respect to the order of
18 neutralization; and, just to make this clear, the order of neutralization that is
19 recited in our claims is such that the monomers -- that is, the carboxylic acid
20 containing monomer units -- are subjected to neutralization prior to
21 polymerization. If we look at the Ostrowicki patent and compare that with the
22 examples in our specification and our disclosure, you see that what that
23 difference boils down to in some embodiments is that in Ostrowicki they have
24 several feed lines that can concurrently lead to a reactor. And they feed all of
25 the feeds concurrently. They mix together as they enter the reactor, so

1 polymerization is occurring concurrently, at best, in Ostrowicki.

2 Now, we can contrast that with our examples in the original
3 specification where we are describing the mixture of two feed lines, at least
4 two feed lines together, those feed lines being our carboxylic acid-containing
5 monomer and a base. So what that boils down to is as those feed lines mix
6 prior to their entry into the reactor, you have neutralization of the monomer
7 mixture before polymerization. And that is the aspect of the invention, or at
8 least one of the aspects of the invention, that is not described in Ostrowicki.

9 So we have a series of examples and comparative examples in
10 the specification, and to date the examiner hasn't given that information much
11 weight in determining patentability; and, I just wanted to point out that our
12 inventive example 1 and our comparative example 1 are, in fact, a comparison
13 against Ostrowicki or intended as a comparison against Ostrowicki and to
14 show the importance or the consequence of carrying out the neutralization as
15 we have claimed.

16 Our example 1 has mixing of the base and the carboxylic acid-
17 containing monomer before entry into the reactor compared to example 1
18 does not. And, the consequence of that is a lowered amount of what's called
19 coagulum in our specification. I guess the layman might just call it sticky
20 stuff that interferes with later filtration. So Appellant's' view is that the
21 evidence of record should weigh in favor of patentability, if we, for the
22 purposes of argument only, accept that a *prima facie* case was established,
23 there is evidence of record to rebut that *prima facie* case of obviousness.

24 So that would be the first point that we would make with respect
25 to the rejection, that there is, in fact, evidence supportive of non-obviousness.

1 In at least one instance the Examiner appeared to take the
2 position that the examples of Ostrowicki either don't have very much
3 coagulate or coagulum in comparison to what we have described in our
4 examples; and, if I could just draw the board's attention to -- this will be
5 examples 3 and 4, which are in columns 9 and 10 of Ostrowicki.

6 The Ostrowicki patent describes the amount of coagulate; and,
7 for example, if one looks at the table representing Example 3, it would be the
8 line that's sixth from the bottom; and that's giving an indication of the
9 percentage of the coagulate that is formed in the Ostrowicki example. For
10 example, in experiment number 3, the coagulate is present in an amount of 0.1
11 percent, which is about a thousand ppm. When we compare that with our
12 inventive example, we're getting about a hundred ppm. So we have a
13 substantial reduction in coagulum in our inventive example in comparison
14 with the coagulate formed.

15 JUDGE GAUDETTE: The Examiner made the remark that you
16 only have one example, and that is not commensurate in scope with the
17 claims, because you're only testing very specific monomers. And did you
18 respond to that at all? That's on page 10 of the answer.

19 DR. KOSCHMIEDER: We have pointed out to the Examiner
20 that it is, in fact, what I would call a side-by-side comparison; and, if we look
21 at examples 3 and 4 of Ostrowicki and look at the types of monomers, the
22 types of reactants that are present, those are also present in our inventive
23 example.

24 JUDGE GAUDETTE: But you have a very broad range that
25 you're claiming, and you're only testing one specific set of monomers and one

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1 specific amount of monomers. So how do we know that if you were to test
2 different weight percentages of those same monomers or different monomers,
3 and the only difference being the partial neutralization took place before
4 polymerization?

5 DR. KOSCHMIEDER: Well, I would argue -- Appellants would
6 argue -- that it makes sense. Or, that particular comparison is in fact
7 commensurate in scope, because the Examiner even comes out and concedes -
8 - and I read from the office action -- the only difference between the claims
9 process for preparing a stable, aqueous copolymer version and the prior art is
10 that partial neutralization of the ethylenically unsaturated carboxylic acids or
11 dicarboxylic acids occurs prior to polymerization.

12 So on the one hand -- I understand your point, but on the one
13 hand, the Examiner says, "Well, it's all the same except for this point. So if
14 we distill out the important point identified by the Examiner and show that
15 that important point, the neutralization prior to polymerization, is in fact the
16 basis of a substantial difference in performance.

17 JUDGE GAUDETTE: Right. But the Examiner has relied on
18 secondary references to show that it would be obvious to modify the primary
19 reference to include that or to change the order of the steps.

20 DR. KOSCHMIEDER: Mm-hmm. Well, we can look at, for
21 example, Basu, which is one of the secondary references.

22 JUDGE GAUDETTE: And I don't think you presented any
23 arguments in your brief directed to the secondary references. So we really
24 can't consider any thing that you didn't raise in your appeal brief.

25 DR. KOSCHMIEDER: The board can take that position. The

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1 fact of the matter is there is evidence in the specification directly comparing
2 the effect of the prior addition, or I should say the neutralization of the
3 monomers, prior to polymerization. That is the important effect also where
4 the difference identified by the Examiner between the claimed invention and
5 the prior art, that hasn't been given any weight, so -- up-to-date -- by the
6 Examiner in prosecution.

7 That is evidence that should be considered as probative of
8 patentability. So I think the answer that I can give you today is that in fact,
9 when we look at the Ostrowicki disclosure, when we compare the materials
10 that are present in the Ostrowicki examples with what we've described in the
11 specification in our own examples, it is nearly a side-by-side comparison, and
12 it identifies or isolates the one particular difference identified by the Examiner
13 as being critical.

14 If we, in fact, look at the secondary references, for example, like
15 Basu, there are substantial differences between what is described in secondary
16 references with respect to the composition of the materials that are subjected
17 to polymerization. So whereas our claims recite a very particular mixture of
18 monomers, having a particular maximum amount of the carboxylic acid-
19 containing materials, the Basu and the other references describe different
20 monomer mixtures.

21 So the question -- and not the question, but the fact is what
22 becomes a comparison that is in fact commensurate in scope: one in which
23 we've identified or isolated the particular difference between the claimed
24 invention and the prior art should be given at least some weight towards
25 patentability.

1 Did you have another question, another comment?

2 JUDGE GAUDETTE: No.

3 DR. KOSCHMIEDER: Okay. And I could just take one brief
4 moment to point out that following on the question that, in fact, the materials
5 that are present in the Ostrowicki examples 3 and 4, if we look, for example,
6 in column 9, the Trilon B is also reproduced in the examples of the
7 specification. The emulsifier is also the emulsifier used in the examples of
8 our specification.

9 The APS is just a sulfate material. They use an ammonium
10 cation in the Ostrowicki; sodium cation is used in the examples of our
11 specification. Both the Ostrowicki and the inventive examples describe
12 polymerization of mixtures of styrene, butadiene, and acrylic acid. So there
13 are very direct side-by-side comparisons, so to speak, with respect to the art
14 that's described, or the example that's described, in Ostrowicki.

15 In another, I believe it was in the Examiner's answer, the
16 Examiner made some comment that the coagulate and the deposits that are
17 described in the examples of the Ostrowicki patent may, in fact, be the same
18 thing, and the Examiner pointed to some disclosure in which deposits -- the
19 word "deposits" -- was followed in parentheses with the word "coagulate."
20 And that is at column 4, line 41. It appears that the Examiner is implying that
21 deposits are the same thing as coagulate, and the fact that the Ostrowicki
22 patent doesn't describe the formation of any deposits is somehow evidence
23 that no coagulate or coagulum is formed in the Ostrowicki examples. But if
24 you look at the tables, you see clearly that there is, in fact, a difference
25 between the formation of deposits and the formation of coagulate, because all

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1 of the examples describe reactions that are carried out such that they are free
2 of deposits, but they still include coagulate. So I wanted to address that point,
3 as well.

4 Another point that comes to mind with respect to one of the
5 secondary references is relevant to this point about deposits. One of the bases
6 for alleging that it would be obvious to modify the Ostrowicki patent in the
7 manner that we've claimed is that the Basu, B-a-s-u, reference, suggests that
8 you can get lower amounts of deposits by carrying out a polymerization using
9 certain temporal requirements. But if we look at the examples of Ostrowicki,
10 we see that none of those examples does, in fact, form any deposit. So the
11 point I'm making is that, in fact, it just doesn't make sense to assert that it
12 would be obvious to modify Ostrowicki in a manner that would reduce the
13 number of deposits in view of the fact that the examples show there are no
14 deposits formed.

15 Those are all of the comments that I would like to make. Are
16 there any other questions that I can answer from the board?

17 JUDGE HANLON: Do you have any questions?

18 JUDGE KRATZ: That's it.

19 DR. KOSCHMIEDER: Thank you.

20 JUDGE HANLON: Thank you very much.

21 [The hearing was concluded at 1:15 p.m.]

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